

**Notice of Allowability**

Application No.

10/644,328

Examiner

Taofiq A. Solola

Applicant(s)

BHALAY ET AL.

Art Unit

1626

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address--

All claims being allowable, PROSECUTION ON THE MERITS IS (OR REMAINS) CLOSED in this application. If not included herewith (or previously mailed), a Notice of Allowance (PTOL-85) or other appropriate communication will be mailed in due course. **THIS NOTICE OF ALLOWABILITY IS NOT A GRANT OF PATENT RIGHTS.** This application is subject to withdrawal from issue at the initiative of the Office or upon petition by the applicant. See 37 CFR 1.313 and MPEP 1308.

1. ☐ This communication is responsive to the RCE filed 10/8/04.
2. ☐ The allowed claim(s) is/are 13-25, 27-28 (now 1-15 respectively).
3. ☐ The drawings filed on \_\_\_\_\_ are accepted by the Examiner.
4. ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
  - a) ☒ All b) ☐ Some\* c) ☐ None of the:
    1. ☒ Certified copies of the priority documents have been received.
    2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
    3. ☐ Copies of the certified copies of the priority documents have been received in this national stage application from the International Bureau (PCT Rule 17.2(a)).

\* Certified copies not received: \_\_\_\_\_.

Applicant has THREE MONTHS FROM THE "MAILING DATE" of this communication to file a reply complying with the requirements noted below. Failure to timely comply will result in ABANDONMENT of this application.

**THIS THREE-MONTH PERIOD IS NOT EXTENDABLE.**

5. ☐ A SUBSTITUTE OATH OR DECLARATION must be submitted. Note the attached EXAMINER'S AMENDMENT or NOTICE OF INFORMAL PATENT APPLICATION (PTO-152) which gives reason(s) why the oath or declaration is deficient.
6. ☐ CORRECTED DRAWINGS (as "replacement sheets") must be submitted.
  - (a) ☐ including changes required by the Notice of Draftsperson's Patent Drawing Review (PTO-948) attached
    - 1) ☐ hereto or 2) ☐ to Paper No./Mail Date \_\_\_\_\_.
  - (b) ☐ including changes required by the attached Examiner's Amendment / Comment or in the Office action of Paper No./Mail Date \_\_\_\_\_.

Identifying indicia such as the application number (see 37 CFR 1.84(c)) should be written on the drawings in the front (not the back) of each sheet. Replacement sheet(s) should be labeled as such in the header according to 37 CFR 1.121(d).
7. ☐ DEPOSIT OF and/or INFORMATION about the deposit of BIOLOGICAL MATERIAL must be submitted. Note the attached Examiner's comment regarding REQUIREMENT FOR THE DEPOSIT OF BIOLOGICAL MATERIAL.

**Attachment(s)**

1. ☐ Notice of References Cited (PTO-892)
2. ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
3. ☒ Information Disclosure Statements (PTO-1449 or PTO/SB/08), Paper No./Mail Date 1
4. ☐ Examiner's Comment Regarding Requirement for Deposit of Biological Material
5. ☐ Notice of Informal Patent Application (PTO-152)
6. ☒ Interview Summary (PTO-413), Paper No./Mail Date 1
7. ☒ Examiner's Amendment/Comment
8. ☒ Examiner's Statement of Reasons for Allowance
9. ☐ Other \_\_\_\_\_

Taofiq A. Solola  
Primary Examiner  
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Claims 13-28 are pending in this application.

Claims 1-12 are canceled.

## **DETAILED ACTION**

### ***Election/Restriction***

Restriction to one of the following inventions is required under 35 U.S.C. 121:

- I. Claims 13-25, 27-28, drawn to compounds of formula I, composition, methods of use and process of making thereof, classifiable in class 544, 514 and numerous subclasses.
- II. Claim 26, drawn to compounds of formula IV, classifiable in class 544, and numerous subclasses.

Inventions of groups I and II are not related. They are distinct and independent from each because they are directed to different statutory classes of invention and, the practice of invention II or I would not result in the practice of the other. The inventions are drawn to different compounds having different structures.

In addition, because of the plethora of subclasses in each of the Groups, a serious burden is imposed on the examiner to perform a complete search of the defined areas. For reasons set forth above, the restriction is proper.

Because these inventions are distinct for the reasons given above and have acquired a separate status in the art because of their recognized divergent subject matter, restriction for examination purposes as indicated is proper.

During a telephone call by Gabrielle Brouillette on 6/11/04 a provisional election was made to prosecute the invention of group I, claims 13-25, 27-28, without traversal. Affirmation of this election must be made by applicant in replying to this Office action. Claim 26, is hereby

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withdrawn from further consideration by the examiner, 37 CFR 1.142(b), as being drawn to a non-elected invention, and are now canceled.

Applicant is reminded that upon the cancellation of claims to a non-elected invention, the inventorship must be amended in compliance with 37 CFR 1.48(b) if one or more of the currently named inventors is no longer an inventor of at least one claim remaining in the application. Any amendment of inventorship must be accompanied by a request under 37 CFR 1.48(b) and by the fee required under 37 CFR 1.17(i).

#### ***Examiner's Amendment***

An examiner's amendment to the record appears below. Should the changes and/or additions be unacceptable to applicant, an amendment may be filed as provided by 37 CFR 1.312. To ensure consideration of such an amendment, it MUST be submitted no later than the payment of the issue fee.

Since the election of group I is without traversal and having found the elected invention in condition for allowance, claim 26 is now canceled.

#### ***Interview Summary***

Claims 14-17, 19-25, are dependent on canceled claims. However, in an interview with Ms. Brouillette today, 6/15/04, she indicated that the dependency be retained after renumbering of claims 13-25, 27-28, as was done in the parent Application No. 10/240,481, now abandoned.

#### ***Reasons for Allowance***

The following is an examiner's statement of reasons for allowance: the invention relates to 8-Quinolinxanthine and 8-Isoquinolinxanthine derivatives, their composition, methods of use

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and process of making thereof. No prior art of record discloses the instant invention. Only the priority document discloses the claimed invention. The invention was allowed in parent Application No 10/240,481, now abandoned. In the instant application, claims 27-28, drawn to method of use, are new.

Any comments considered necessary by applicant must be submitted no later than the payment of the issue fee and, to avoid processing delays, should preferably accompany the issue fee. Such submissions should be clearly labeled "Comments on Statement of Reasons for Allowance."

#### ***Telephone Inquiry***

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Taofiq A. Solola, PhD, JD, whose telephone number is (571) 272-0709.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Mr. Joseph McKane, can be reached on (571) 272-0699. The fax phone number for this Group is (703) 872-9306.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the Group receptionist whose telephone number is (571) 272-1600.

  
**TAOFIQ SOLOLA**  
**PRIMARY EXAMINER**  
Group 1626

December 17, 2004